

5C



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,386	08/01/2001	Greg Eippert	27228/04002	4401

24024 7590 01/12/2005

CALFEE HALTER & GRISWOLD, LLP
800 SUPERIOR AVENUE
SUITE 1400
CLEVELAND, OH 44114

EXAMINER

HENDERSON, MARK T

ART UNIT PAPER NUMBER

3722

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/920,386	EIPPERT, GREG	
	Examiner	Art Unit	
	Mark T Henderson	3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 13-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3722

DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1, 2, 10, 13, 14, and have been amended for further examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3722

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 7-10 and 13-15 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Whaley (5,995,938) in view of Rush (1,073,364).

Whaley discloses a system of reminding a patient comprising a sheet (156) depicting one or more rows (158) and columns (160, 162, 164, 166, 168, 170) to form a matrix comprising a plurality of fields (boxes on the chart); wherein the row and columns further include headers ("MORNING", "NOON", ..etc) defining parameters; wherein the headers include medical markings (textual notes) which include indicators of medication ("MEDICINES"), and icons (in Fig. 7 and 11), and indicia markings (172, 174, 176, 178) disposed outside of the matrix; and one or more color coded stickered (94, shown in Fig. 4) medication (prescription) containers (not shown, but stated in Col. 5, lines 32-39, wherein the sticker (94) can be placed on any part of the container housing, which includes the cap). Whaley further discloses in Fig. 7 and 11, a reminder system comprising medical markings (138, 142, 150) representing a time period within a day.

However, Whaley does not disclose: wherein one or more rows are completely color shaded and shaded with different colors; medications related to ophthalmology; markings designate which eye to place medication within.

Art Unit: 3722

Rush discloses in Fig. 1, a system comprising rows wherein rows and columns are filled in entirely (as shown in the Totals section at the bottom of the chart) by filling in individual row cells with colors as necessary (Col. 1, lines 40-56 and Col. 2, lines 57-80).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Whaley's system to include designating a field within each row for color identification using a various colors as taught by Rush for the purpose of color coding the matrix.

In regards to **Claims 4**, a recitation of the intended use of the claimed invention (medications which relate to ophthalmology; and markings which designate which eye to place medication within) must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the reminding system of Mayfield as modified by Whaley is capable of having medications which relate to ophthalmology.

In regards to **Claim 5**, the method in which the medical markings designate which eye to place the medication within does not structurally limit the claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the

Art Unit: 3722

prior art was made by a different process (see MPEP 2113). Therefore, it would be obvious to incorporate medical markings which designate the use of medications..

3. Claims 6, 16, 18 and 19 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Whaley in view of Rush, and further in view of North et al (5,992,888).

Whaley as modified by Rush discloses a reminder system comprising all the elements as claimed in Claims 1 and 3, and as set forth above.

However, Whaley as modified by Rush does not disclose: advertising markings and coupons which correspond to one of the medication indicators; and a plurality of areas for placing advertising markings.

North et al discloses in Fig. 1-4 and 9, a reminder system comprising advertising markings (11) placed in an area, and coupons (16).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Whaley's and Rush's reminder system to include advertising markings and coupons in place of the indicia markings as taught by North et al for the purpose of providing an advertising method which focuses specific advertising material to a preselected market segment, which may be used by the end user.

In regards to **Claims 6, 16 and 19**, in which the advertising markings correspond to one of the medication indicators, or a pharmacy, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in

Art Unit: 3722

order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the advertising markings and coupons of North et al are capable of corresponding to medication indicators and to a pharmacy depending on the indicia printed in the advertising area and on the coupons.

In regards to **Claims 18 and 19**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include as many areas as desired to place advertising markings, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. Therefore, it would have been obvious to include as many areas as desired, since applicant has not disclosed the criticality of having a plurality of areas for placing advertising marking, and invention would function equally as well with any number of areas and would serve the end user by giving holding information related to the reminder system.

4. Claim 17 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Whaley in view of Rush and further in view of Cutting (4,295,664).

Whaley discloses a system of reminding a patient comprising a sheet (156) depicting one or more rows (158) and columns (160, 162, 164, 166, 168, 170) to form a matrix comprising a plurality of fields (boxes on the chart); wherein the row and columns further include headers ("MORNING", "NOON", ..etc) defining parameters; wherein the headers include medical markings (textual notes) which include indicators of medication ("MEDICINES"), and icons (in Fig. 7 and 11), and indicia markings (172, 174, 176, 178) disposed outside of the matrix; and one

Art Unit: 3722

or more color coded medication (prescription) containers (not shown, but stated in Col. 5, lines 32-39). Whaley further discloses in Col. 9, lines 64-67 that the chart can be multiple pages depending on the number of medications.

However, Whaley does not disclose: wherein one or more rows are color shaded with different colors; and tablet of multiple sheets of paper.

Rush discloses in Fig. 1, a system comprising rows, wherein rows and columns are filled in not entirely by filling in individual cells with colors as necessary (Col. 1, lines 40-56 and Col. 2, lines 57-80).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Whaley's system to include designating a field within each row for color identification using a various colors as taught by Rush for the purpose of color coding the matrix.

However, Whaley as modified by Rush does not disclose a tablet of multiple sheets of paper.

Cutting discloses in Fig. 1-4, a system reminder comprising a tablet of multiple sheets.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Whaley's and Rush's system to include a tablet of multiple sheets as taught by Cutting for the purpose of keeping track of multiple records of information.

Art Unit: 3722

Prior Art References

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Suwa, Zumeta, Tenorio, and Sonoyama et al disclose chart systems having rows and columns, wherein the row are color-coded in which they are shaded in completely to decipher on row from another.

Response to Arguments

5. Applicant's arguments filed on July 17, 2003 have been fully considered but they are not persuasive.

In response to applicant's arguments that the prior art does not disclose "wherein one or more rows are completely color-shaded, the examiner submits that the Whaley reference is used to disclose a reminder system structure as claimed by applicant. The Rush reference is now used to recite a system having row and columns, wherein at least one or more rows are color-shaded in completely. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Whaley's system to include designating a field within each row for color identification using a various colors as taught by Rush for the purpose of color coding the matrix.

Art Unit: 3722

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

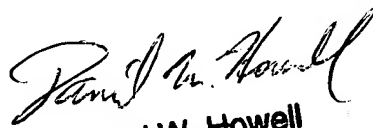
Art Unit: 3722

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.

MTH

January 9, 2005


Daniel W. Howell
Primary Examiner
Art Unit 3722